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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/621,399

07/18/2003

Koji Yonehara

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2449

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7590

02/19/2008

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EXAMINER

OH, TAYLOR V

ART UNIT

PAPER NUMBER

1625

MAIL DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/621,399

**Applicant(s)**

YONEHARA ET AL.

**Examiner**

Taylor Victor Oh

**Art Unit**

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-9,15 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,15 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **Final Rejection**

### **The Status of Claims**

Claims 1,3-9,15 and 21 are pending.

Claims 1,3-9,15 and 21 are rejected.

### **Claim Rejections - 35 USC § 112**

Applicants' argument filed 11/27/2007 have been fully considered but are not persuasive.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of Claims 11-15 under 35 U.S.C. 112, first paragraph, has been withdrawn due to the cancellation and modification of claims; however,

In Claim 15, there is still some issue to be resolved in the phrase "the method of reducing the risk of a tungsten species leaching." After reviewing the phrase, this expression is considered to be the same as the language of the method of preventing tungsten species leaching out.

Furthermore, in view of the revised claims in the amendment, Claims 1,3-9,15 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter

which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

“The factors to be considered [in making an enablement rejection] have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in that art, the predictability or unpredictability of the art, and the breadth of the claims”

Claims are drawn to the generic method of reducing the risk of a tungsten species leaching. The meaning of the phrase “reducing the risk” is the same as that of preventing any tungsten species leaching out” during the process. However, applicants are not enabled for reducing the risk of the tungsten species leaching during the process of carrying out liquid-phase oxidation reaction using the catalyst containing tungsten species. There are very few selected examples such as W/Zn-SnO<sub>2</sub>, W/Zn-SnO<sub>2</sub>, Fe<sub>2</sub>SiW<sub>10</sub>O<sub>38</sub>/Zn-SnO<sub>2</sub> from tables 5, 6, and 7 with zero % leaching in the specification, whereas the other examples in the tables 1-3 are far from showing the true prevention of the tungsten

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species leaching during the process. Thus, there is no evidence of record that would guide the skilled artisan to identify which catalyst containing the tungsten species can be surely prevented from leaching out. The Examiner suggests deletion of the word "preventing" and the phrase "reducing the risk". Therefore, an appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claim 21 under 35 U.S.C. 112, second paragraph, has been withdrawn due to the modification of claim.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. The rejection of Claims 1,4-5, 7-9, and 21 under 35 U.S.C. 102(b) as being anticipated clearly by Neumann et al (WO 98/54165) has been withdrawn due to the modification of claims.

2. The rejection of Claims 1,3-7, 9, and 21 under 35 U.S.C. 102(b) as being anticipated clearly by Brown et al (WO 94/21583) has been withdrawn due to the modification of claims.

3. The rejection of Claims 1,4-5, 7-9, and 21 under 35 U.S.C. 102(b) as being anticipated clearly by Watanabe et al (J. of Molecular Catalysis A : Chem.. 145 (1999), p. 281-289) has been withdrawn due to the modification of claims.

4. Claims 1,4-5, 7-9 , and 21 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Brown et al (WO 93/00338) has been withdrawn due to the modification of claims.

#### Applicants' Argument

Applicants argue the following issues:

- a. The rejection of Claims 11-15 under 35 U.S.C. 112, first paragraph, has been overcome by reciting "reducing the risk" in place of "preventing".

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Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the applicants' argument, the Examiner has noted applicants' arguments. However, as indicated in the above, the meaning of the phrase "reducing the risk" is the same as that of preventing any tungsten species leaching out during the process. Furthermore, applicants are not enabled for reducing the risk of the tungsten species leaching during the process of carrying out liquid-phase oxidation reaction using the catalyst containing tungsten species. Therefore, applicants' argument is not persuasive.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be


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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
/Taylor Victor Oh/  
Primary Examiner, Art Unit 1625

2/14/08